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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/443,293	11/19/1999	SATOSHI EJIMA	104776	7003

25944 7590 11/04/2003

OLIFF & BERRIDGE, PLC  
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EXAMINER

BRINICH, STEPHEN M

ART UNIT	PAPER NUMBER
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2624

DATE MAILED: 11/04/2003

10

Please find below and/or attached an Office communication concerning this application or proceeding.



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Commissioner for Patents

## Office Action Summary

**Application No.**

09/443,293

**Applicant(s)**

EJIMA ET AL.

**Examiner**

Stephen M Brinich

**Art Unit**

2624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☐ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) 1-21 and 25-36 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 22-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

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**DETAILED ACTION**

***Election/Restrictions***

1. Applicant's election with traverse of claims 22-24 in Paper No. 9 is acknowledged. The traversal is on the ground(s) that Groups I-III are not separate and distinct. This is not found persuasive for the following reasons:

Applicant argues (Paper #9, page 1, line 20 - page 2, line 8) that the utility of performing an acceptability evaluation based on the result of compression is not a separate utility from performing an acceptability evaluation in general.

However, a person of ordinary skill in the image processing art will recognize a number of acceptability evaluation criteria other than image compression (e.g. image brightness, image color fidelity, image sharpness), any one of which defines a separate utility for an "acceptability evaluation in general" that is not specifically related to image compression.

Applicant argues (Paper #9, page 2, lines 9-16) that Group I and Group III do not have separate utility, as both recite an evaluation device and an acceptability selection device/mode.

This argument appears to be directed to the proposition that Group I and Group III are not separate inventions. Such a conclusion, even if granted, would appear moot given that

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Applicant has elected neither Group I nor Group III for examination, and has not addressed the elected Group II.

In any case, Examiner maintains that the evaluation device and acceptability selection device/mode of Group I has separate utility from that of Group III, because the former is applicable in the case of images evaluation and acceptability selection separate from the control of an image pickup device (e.g. for evaluation and selection of previously obtained images).

Applicant argues (Paper #9, page 2, line 17 - page 3, line 2) that examination of the entire application could be made without serious burden.

However, the recitation of an acceptability evaluation and image pickup control not specific to image compression would clearly require additional consideration and search of a plethora of various other fields of image acceptability evaluation and image pickup control related to image brightness, image sharpness/focus, image color saturation, etc.

The requirement is still deemed proper and is therefore made FINAL.

***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless -

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 22-24 are rejected under 35 U.S.C. 102(e) as being anticipated by Zador.

Re claim 22, Zador discloses (Abstract; column 25, line 11 - column 26, line 59, particularly column 25, lines 26-59 and column 26, lines 20-28) an image processor in which an image compression device acts to compress image data, a plurality of sets of image data (the levels of an image tree) are continuously obtained and evaluated according to an acceptability criterion (e.g. Mean Squared Error) and post-compression data quantity, and the selected data is recorded.

Re claims 23-24, Zador discloses (column 26, lines 20-28) the use of additional processing to produce a different set of compressed data if a given set of compressed data is found to exceed an allowable range of post-compressed data according to a determined data selection parameter (the bit plane at which the allowable size range is exceeded).

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**Conclusion**

4. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

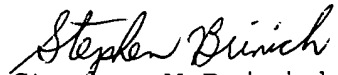
Kanno et al. (Figure 14) and Fan (Figure 4) disclose examples of selectable or adjustable image compression based on particular criteria.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen M. Brinich at 703-305-4390. The examiner can normally be reached on weekdays 7:00-4:30, alternate Fridays off.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Tech Center 2600 Customer Service center at 703-306-0377.

If attempts to contact the examiner and the Customer Service Center are unsuccessful, supervisor David Moore can be contacted at 703-308-7452.

Faxes pertaining to this application should be directed to the Tech Center 2600 official fax number, which is 703-872-9306.

  
Stephen M Brinich  
Examiner  
Art Unit 2624

smb  
October 31, 2003